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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,370	03/23/2004	Xiao Yonghong	002973.00055	2513

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BANNER & WITCOFF, LTD.  
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SUITE 1200  
WASHINGTON, DC 20005-4051

EXAMINER
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RAMIREZ, DELIA M

ART UNIT	PAPER NUMBER
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1652

MAIL DATE	DELIVERY MODE
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05/11/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/806,370

Applicant(s)

YONGHONG ET AL.

Examiner

Delia M. Ramirez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 31-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31,32,34,36,37 and 39 is/are rejected.
- 7) ☒ Claim(s) 33,35 and 38 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of the Application***

Claims 31-39 are pending.

Applicant's amendment of claim 31 in a communication filed on 2/20/2007 is acknowledged.

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

### ***Specification***

1. In view of Applicant's amendment to the specification, prior objections are hereby withdrawn.

### ***Claim Rejections - 35 USC § 112, First Paragraph***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 31-32, 34, 36-37, 39 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
4. Claims 31-32, 34, 36-37, 39 remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an *in vitro* method of screening for agents that can regulate the enzymatic activity of the polypeptide of SEQ ID NO: 12, does not reasonably provide enablement for an *in vivo* method of screening for agents that can regulate the enzymatic activity of the polypeptide of SEQ ID NO: 12. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

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5. These rejections have been discussed at length in the Non Final action mailed on 11/17/2006 and they are maintained for the reasons of record and those set forth below.

6. Applicant argues that claim 31 now recites subject matter which the Office action acknowledges as described and enabled.

7. Applicant's amendment to claim 31 is acknowledged. However, the Examiner respectfully disagrees with Applicant's contention that amended claim 31 encompasses subject matter which the Office acknowledges as described and enabled. As clearly indicated in the Non Final action mailed on 11/17/2006, one of the grounds of rejection under 35 USC, 112, first paragraph, written description and enablement, was the fact that the claims encompass in part an *in vivo* method of screening for agents that can regulate enzymatic activity. The Examiner extensively discussed the reasons why such *in vivo* method is not adequately described or enabled by the teachings of the specification. See, particularly, page 6, first full paragraph, page 8, item 15, pages 9-14. Also, it is noted that the Non Final action under "Allowable Subject Matter" states that only the *in vitro* method is deemed allowable. Therefore, since claims 31-32, 34, 36-37, 39 are still directed in part to an *in vivo* method of screening for agents that can regulate the enzymatic activity of the polypeptide of SEQ ID NO: 12, these rejections are maintained for the reasons of record.

8. Claims 31-39 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the claims were rejected as there is no indication in the specification as to public availability of the recited biological material. In view of Applicant's statement in the Remarks section of the communication filed on 2/20/2007, page 6, indicating that the deposited plasmid will be available to the public under the conditions specified in 37 CFR 1.808, this rejection is hereby withdrawn.

***Claim Rejections - 35 USC § 102***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 31-33, 35-37 were rejected under 35 U.S.C. 102(a) as being anticipated by Morser et al. (WO 99/64608, published 12/16/1999; cited in the IDS). In view of Applicant's amendment of claim 31 which no longer encompasses practicing the claimed method with variants of the polypeptide of SEQ ID NO: 12, and the fact that Morser et al. do not teach the claimed method with the polypeptide of SEQ ID NO: 12, this rejection is hereby withdrawn.

***Claim Rejections - 35 USC § 103***

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 38-39 were rejected under 35 U.S.C. 103(a) as being unpatentable over Morser et al. (WO 99/64608, published 12/16/1999; cited in the IDS) in view of Bandman et al. (U.S. Patent No. 5925521, issued 7/20/1999). In view of Applicant's amendment of claim 31 which no longer encompasses practicing the claimed method with variants of the polypeptide of SEQ ID NO: 12, and the fact that neither Morser et al. nor Bandman et al. teach or suggest the polypeptide of SEQ ID NO: 12, this rejection is hereby withdrawn.

13. Claims 31-33, 35-39 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. (Biochimica et Biophysica Acta 1518:204-209; cited in the IDS) in view of Morser et al. (WO 99/64608, published 12/16/1999; cited in the IDS) and further in view of Bandman et al. (U.S. Patent No. 5925521, issued 7/20/1999). In view of Applicant's amendment of claim 31 which no longer encompasses practicing the claimed method with variants of the polypeptide of SEQ ID NO: 12, and the fact that

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neither Morser et al., Kim et al., nor Bandman et al. teach or suggest the polypeptide of SEQ ID NO: 12, this rejection is hereby withdrawn.

***Allowable Subject Matter***

14. Claims 33, 35 and 38 appear to be allowable over the prior art of record but are objected to as dependent upon a rejected base claim.

***Conclusion***

15. No claim is in condition for allowance.

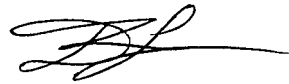
16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Delia M. Ramirez whose telephone number is (571) 272-0938. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy can be reached on (571) 272-0928. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.



Delia M. Ramirez, Ph.D.  
Patent Examiner  
Art Unit 1652

DR  
May 2, 2007